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TO: EXAMINER K. NEGASH

FACSIMILE NO.: 1-703-872-9306

FROM: George M. Kaplan, Esq.

PAGES: 8 (including this page)

YOUR REF: Serial No. 09/232,119

OUR REF: 298-73

COMMENT:

Enclosed, please find an **REQUEST FOR WITHDRAWAL OF FINALITY OF OFFICE ACTION**. Please confirm receipt of these documents by return facsimile. Thank you

Thank you.
George M. Kaplan

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JAN 23 2004

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Weitzel

Examiner: Negash, K.

Appln. No.: 09/232,119

Group: 2633

Filed: January 15, 1999

Docket: 298-73

For: A DEVICE TO DETECT
OR GENERATE OPTICAL SIGNALS

Date: January 21, 2004

OFFICIALCommissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450REQUEST FOR WITHDRAWAL OF FINALITY OF OFFICE ACTION

It is respectfully requested finality of the Office Action mailed December 12, 2003 in the above-identified application be withdrawn for the following reasons.

The present application is a Request for Continued Examination (RCE) of an earlier application. An Amendment filed with the RCE papers explicitly amended several of the claims to address the rejections under 35 U.S.C. §112, second paragraph raised in the final Office Action mailed August 8, 2002, with Claims 50-52 being added. Another copy of DE 3820170 and Form PTO-1449 listing the same, was also enclosed with this Amendment in response to paragraph 2 of the final Office Action mailed August 8, 2002 and which states a legible copy of this reference had not been placed in the file (even though a legible copy of this reference had, in fact, been submitted with the Information Disclosure Statement timely filed May 17, 1999).

CERTIFICATE OF FACSIMILE

I hereby certify that this paper is being facsimile transmitted to the Patent and Trademark Office (1-703-872-9306) on the date shown below.

Dated: January 21, 2004
George M. Kaplan

A restriction/election requirement was then raised in the subsequent Office Action mailed July 25, 2003. In the present Office Action, Claims 21-49 have been rejected under 35 U.S.C. § 112, second paragraph, Claim 50 allowed and Claims 51 and 52 withdrawn from consideration. However, Form PTO-1449 submitted with Amendment filed with the RCE papers, was not appended to the Office Action mailed December 12, 2003.

37 CFR §1.114, which governs Request for Continued Examination, reads, in pertinent part, as follows:

(a) If prosecution in an application is closed, an applicant may request continued examination of the application by filing a submission and the fee.....

(c) A submission as used in this section includes, but is not limited to, an information disclosure statement, an amendment to the written description, claims, or drawings, new arguments, or new evidence in support of patentability. . .

(d) If an applicant timely files a submission and fee, the Office will withdraw the finality of any Office action and the submission will be entered and considered. . . . [emphasis added]

Additionally, M.P.E.P. §706.07(h)V. which addresses filing an RCE after final rejection, explicitly states the following:

If an applicant timely files an RCE with the fee. . . and a submission, the Office will withdraw the finality of any Office action to which a reply is outstanding and the submission will be entered and considered [emphasis added]

Thus, 37 CFR §1.114 and M.P.E.P. §706.07(h)V. explicitly state that finality of a preceding Office Action should be withdrawn if a submission is filed with

the Request for Continued Examination. (1)The Amendment and (2) accompanying copies of Form PTO-1449 with the reference, as filed with the RCE papers, certainly each constitute an acceptable form of such submission, as enunciated in 37 CFR § 1.114.

Furthermore, M.P.E.P. §706.07(h)II., which specifically addresses the submission requirement, explicitly states the following, in pertinent part:

Consideration of whether any submission is responsive within the meaning of 37 CFR 1.111 to the last outstanding Office action is done without factoring in the "final" status of such outstanding Office action. Thus, a reply which might not be acceptable as a reply under 37 CFR 1.113 when the application is under a final rejection may be acceptable as a reply under 37 CFR 1.111 [emphasis added]

Accordingly, as explicitly enunciated in this section of the M.P.E.P., "finality" of a previous Office Action should not be the controlling factor when considering a submission, e.g., an Amendment or Information Disclosure Statement, filed with a Request for Continued Examination (RCE).

Moreover, M.P.E.P. §706.07(h)VIII. addresses the very limited circumstance where a first Action after filing an RCE can indeed be made final:

The action immediately subsequent to the filing of an RCE with a submission and fee. . .may be made final only if the conditions set forth in MPEP §706.07(b) for making a first action final in a continuing application are met [emphasis added].

In this regard, M.P.E.P. §706.07(b) reads, in pertinent part, as follows:

The claims of a new application may be finally rejected in the first Office action in those situations where (A). . . ., and (B) all claims of the new application (1) are drawn to the same invention claimed in the earlier application, and (2) would have been properly finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application [emphasis added].

In the present instance, the claims introduced by the Amendment filed with the RCE papers are clearly not all directed to the same invention claimed in the earlier application. This has even been acknowledged by the Examiner who raised a restriction/election requirement for the very first time in the Office Action mailed July 25, 2003. Furthermore, Claim 50, which was added by this Amendment, has been allowed (no claim was indicated allowable prior to filing the RCE). Moreover, the claims have been amended to explicitly address the rejection raised in the final Office action mailed August 8, 2002.

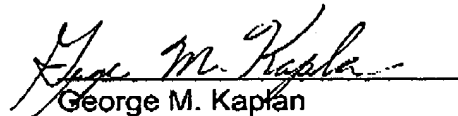
Therefore, at the very least, it is clear the presently pending claims are not all directed to the same invention claimed in the earlier application. Accordingly, the Office action mailed December 12, 2003 should not be made final, in light of the very strict requirements in M.P.E.P. §§706.07(h)VIII. and 706.07(b) for making such action final.

Additionally another copy of Form PTO-1449 is enclosed, it respectfully being requested that DE 3820170 be initialed upon this form as having been properly considered by the Examiner. Moreover, another copy of Form PTO-

1449 appended to the previous Office Action mailed November 6, 2001 by the Patent and Trademark Office is enclosed, it respectfully being requested that the box next to the Japanese Abstracts citation be initialed by the Examiner as having been properly considered (please contact the undersigned attorney should another copy of this citation be required by the Examiner).

Accordingly, it is respectfully requested finality of the Office action mailed December 12, 2004 be withdrawn, with the new response term set to run from the date of reissuance of the forthcoming nonfinal Office action and the citations listed upon both enclosed Forms PTO-1449 being initialed as having been properly considered by the Examiner.

Respectfully submitted,


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Attorney for Applicant(s)

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U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICEINFORMATION DISCLOSURE
STATEMENT BY APPLICANT

(Use several sheets if necessary)

ATTY. DOCKET NO.

298-73

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AUG 23 2001

Technology Center 2600

SERIAL NO.

09/232,119

APPLICANT

Thilo Weitzel

FILING DATE

1/15/99

GROUP

Art Unit 233

U.S. PATENT DOCUMENT

EXAMINER INITIALS	DOCUMENT NUMBER	DATE	NAME	CLASS	SUBCLASS	FILING DATE IF APPROPRIATE
LN	5 0 5 9 0 2 7	10/91	Roesler, et al.	318	346	

FOREIGN PATENT DOCUMENTS

DOCUMENT NUMBER	DATE	COUNTRY	CLASS	SUBCLASS	TRANSLATED YES
0 2 9 7 5 5 6	01/89	European			

OTHER DOCUMENTS (Including Author, Title, Date, Pertinent Pages, Etc.)

LN	Patent Abstracts of Japan No. 04055726, February 24, 1992 and JP 02165566

EXAMINER

DATE CONSIDERED

11/2/01

EXAMINER: Initial if citation considered, whether or not citation is in conformance with MPEP 609; Draw line through citation if not in conformance; not considered. Include copy of this form with next communication to applicant.

(Form PTO-1449 [6-)

Sheet 1 of 1

Form PTO-1449	U.S. DEPARTMENT OF COMMERCE PATENT AND TRADEMARK OFFICE INFORMATION DISCLOSURE STATEMENT BY APPLICANT (Use several sheets if necessary)	ATTY. DOCKET NO. 228-73	SERIAL NO. 09/232,119
		APPLICANT Thilo Weitzel	
		FILING DATE 1/15/99	GROUP Art Unit 2733

U.S. PATENT DOCUMENT

EXAMINER INITIALS	DOCUMENT NUMBER	DATE	NAME	CLASS	SUBCLASS	FILING DATE IF APPROPRIATE

FOREIGN PATENT DOCUMENTS

DOCUMENT NUMBER	DATE	COUNTRY	CLASS	SUBCLASS	TRANSLATION
3 8 2 0 1 7 D	12/89	FEDERAL REPUBLIC OF GERMANY			

OTHER DOCUMENTS (Including Author, Title, Date, Pertinent Pages, Etc.)

EXAMINER

DATE CONSIDERED

EXAMINER: Initial if citation considered, whether or not citation is in conformance with MPEP 609; Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

(Form PTO-1449 [6-4])